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CHA & REITER, LLC 210 ROUTE 4 EAST PARAMUS, NJ 07652				
EXAMINER MEHRPOUR, NAGHMEH				
ART UNIT 2686				
PAPER NUMBER				

DATE MAILED: 01/27/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.  
**09/769,996**

Applicant(s)

**Ulrich Rphs**

Examiner  
**Naghme Mehrpour**

Art Unit  
**2686**



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on Nov 14, 2003
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-13 is/are pending in the application.
- 4a) Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-13 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claims \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some\* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_ 6) ☐ Other:

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***Claim Rejections - 35 USC § 102***

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. **Claims 1-3, 9, 13**, are rejected under 35 U.S.C. 102(e) as being anticipated by Parikh (Patent Number 6,408,177).

Regarding **claims 1-2, 9**, Parikh teaches a method for exchanging a message using a short message service (SMS) between a sending party and a receiving party, the method comprising the steps of creating a text message by said sending party in a first portable digital phone (col 3 lines 30-34), creating a plurality of optional response messages associated with said text message (col 3 lines 35-47), and forwarding said text message with said optional response messages to said receiving party via said SMS channel (col 3 lines 48-67, col 4 lines 1-2).

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Regarding **claims 3, 13**, Parikh teaches a method wherein one of said optional response messages includes a call-back number allowing a response entered by said receiving party to be transmitted back to said sending party (col 4 lines 31-38).

***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. **Claims 4-8, 10-12**, are rejected under 35 U.S.C. 103(a) as being unpatentable over Parikh et al. (US patent Number 6,408,177 B1) in view of Coad et al. (US Patent Number 5,966,652).

Regarding **claim 4**, Parikh teaches a method wherein said optional response messages are stored in memory of call management center for the second phone and a provision to said receiving party thereafter (col 7 lines 49-57). Parikh fails to teach that the response messages are stored in the memory of the second phone. However Coad teaches a text Messaging system wherein the response messages are stored in the memory of the second phone. Therefore, it would have been obvious to ordinary skill in the art at the time the invention was made to provide above teaching of Coad to Parikh, in order to provide transmitted text messages contained text data portions that

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can be readily extracted by the cellular phone, and providing an easy-to-use visual display of menu option to the user.

Regarding **claims 5, 10**, Parikh teaches a method for exchanging a message using a short message service (SMS) between a sending party and a receiving party (col 3 lines 32-42), the method comprising the steps of :

detecting a message having a plurality of optional response messages stored in call management center for the receiving party retrieving to display said text message with said optional messages (col 3 lines 35-59),

selecting one of said optional response messages by said receiving party, forwarding said selected optional response message back to said sending party via said SMS channel (col 3 lines 48-67, col 4 lines 1-3). Parikh fails to teach that the response messages are stored in the memory of the second phone, and **the plurality of optional response message is selectively provided by the sending party**. However Coad teaches a text Messaging system wherein the response messages are stored in the memory of the second phone, **and the plurality of optional response message is selectively provided by the sending party** (col 5 lines 15-41). Therefore, it would have been obvious to ordinary skill in the art at the time the invention was made to combine the above teaching of Coad with Parikh, in order to provide transmitted text messages contained text data portions that can be readily extracted by the cellular phone.

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Regarding **claim 6**, Parikh teaches a method of wherein said optional response messages comprises a plurality of items identifying different messages to be selected by said receiving party (col 5 lines 11-24).

Regarding **claim 7**, Parikh teaches a method wherein the optional message are transmitted to the receiving party by the sending party (col 3 lines 60-67, col 4 lines 1-2).

Regarding **claim 8**, Parikh teaches a method wherein the optional message include a call-back number allowing the selected response entered by the receiving party to be transmitted back to the sending party (col 4 lines 30-38).

Regarding **claim 11**, Parikh teaches a method further comprising the step of retrieving the text message and the optional messages for a provision to the receiving party (col 3 lines 51-59).

Regarding **claim 12**, Parikh teaches a a method further comprising the step of displaying the retrieved message in a display unit of the second digital terminal (col 1 lines 12-20, col 2 lines 50-53).

#### ***Response to Arguments***

5. Applicant's arguments filed 11/14/03 have been fully considered but they are not persuasive.

In response to the applicant argument that "*an affidavit or declaration filed in claiming priority based on Korean patent application, which was filed on January 28, 2000*", examiner states that priority papers such as those submitted under 35 U.S. C. 119 (a)-(d), filed January 25

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2001, has a Priority Date Claimed of January 19, 2001 (German Appl. No. 201 01), and there is no copy of an English translation of Korean Application filed on January 28, 2000 submitted with this amendment

Applicant's further argues that Parikh reference was issued on June 18, 2003, examiner disagrees, and states that the record of prior art discloses that Parikh reference was issued on June 2002.

In response to applicant's argument that, Parikh fails to teach the plurality of optional response messages is selectively provided by the sending party, and there is no suggestion to combine Parikh and Coad, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, Parikh teaches a method for exchanging a message using a short message service (SMS) between a sending party and a receiving party (col 3 lines 32-42), by detecting a message having a plurality of optional response messages stored in call management center for the receiving party retrieving to display said text message with said optional messages (col 3 lines 35-59), selecting one of said optional response messages by said receiving party, forwarding said selected optional response message back to said sending party

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via said SMS channel (col 3 lines 48-67, col 4 lines 1-3). Parikh fails to teach that the response messages are stored in the memory of the second phone, and **the plurality of optional response message is selectively provided by the sending party**. However Coad teaches a text Messaging system wherein the response messages are stored in the memory of the second phone, **and the plurality of optional response message is selectively provided by the sending party** (col 5 lines 15-41). Therefore, by combining the above teaching of Coad with Parikh providing transmitted text messages contained text data portions that can be readily extracted by the cellular phone, and also providing an easy-to-use visual display of menu option to the user.

### **Conclusion**

**7. Any responses to this action should be mailed to:**

Commissioner of Patents and Trademarks

Washington, D.C. 20231

**or faxed to:**

(703) 872-9314, (for formal communications indented for entry)

**Or:**

(703) 308-6306, (for informal or draft communications, please label

“PROPOSED” or “DRAFT”)



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Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive, Arlington, Va., sixth Floor (Receptionist).

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the technology Center 2600 Customer Service Office whose telephone number is (703) 306-0377.

Any inquiry concerning this communication or earlier communication from the examiner should be directed to Melody Mehrpour whose telephone number is (703) 308-7159. The examiner can normally be reached on Monday through Thursday (first week of bi-week) and Monday through Friday (second week of bi-week) from 6:30 a.m. to 5:00 p.m.

If attempt to reach the examiner are unsuccessful the examiner's supervisor, Marsha Harold-Banks be reached (703)308-5576.

NM

Jan 21, 2004

*Marsha D. Banks-Harold*  
MARSHA D. BANKS-HAROLD  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 2600